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EXAMINER	
RICE, ELISA M	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/510,138	UEDA, YUTAKA	
	Examiner	Art Unit	
	ELISA M. RICE	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *04 October 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/04/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

> Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.
>
> When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare In re Lowry, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and Warmerdam, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).
>
> In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See Lowry, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claims 1 and 15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 1 and 15 define an information recording medium embodying functional descriptive material. However, the claim does not define a computer-readable medium or computer-readable memory and is thus non-statutory for that reason (i.e., "When functional descriptive material is

recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). The scope of the presently claimed invention encompasses products that are not necessarily computer readable, and thus NOT able to impart any functionality of the recited program. The examiner suggests amending the claim(s) to embody the program on "computer-readable medium" or equivalent; assuming the specification does NOT define the computer readable medium as a "signal", "carrier wave", or "transmission medium" which are deemed non-statutory (refer to "note" below). Any amendment to the claim should be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5,7-12,14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiso et al.(JP 2001-103415A provided in IDS) in view of Asada et al. (JP 2001-223980 provided in IDS).

Regarding claim 1,8, and 15, Kiso discloses an information recording medium in which a computer readable, comprising: an image data displayed for a slide show on a display section(Kiso, "A displaying means which can display a slide image, and a memory measure which memorized two or more graphics files, As it had the sequence table which defined an order on which two or more pictures are displayed in a slide show, said graphics file was read from said memory measure according to an order defined as a sequence table and it was made to display on said displaying means, it was made to perform a slide show.", paragraph 4); a program for enabling a computer to function as a slide show section to display a slide show based on the image data on the display section (Kiso, "When a CD-ROM 6 is set to a CD-ROM read means 6 and an entry instruction means gives a start instruction of a slide show execution program 6a to the means 6, an arithmetic control means 1 reads the slide show execution program 6a to act as a slide show execution means. In the case of executing a slide show, the arithmetic control means 1 first reads a sequence table 6b to extract an image file defined in the sequence table 6b from an image file group 6c and allows a display means 3 to display the image.", abstract, IDS art).

Kiso does not disclose wherein a recording format of each of plural different sets of the image data and the program corresponds to one of the different kinds of video audio reproducing apparatuses.

Asada teaches wherein a recording format of each of plural different sets of the image data and the program corresponds to one of the different kinds of video audio reproducing apparatuses (Asada, "In the recoding medium, a picture file system 100

composed of a directory for MPEG animation 400 for recording an MPEG animation file, a directory for an MPEG still picture 500 for recording an MPEG still picture file, a directory for a JPEG still picture 600 for recording a JPEG still picture file and a management file 300 for recording management information showing a relation between the MPEG still picture file and the JPEG still picture file is constructed to record the same still picture in the directories 500 and 600 as the MPEG still picture file and the JPEG still picture file. In order to additionally record or delete a still picture, the MPEG still picture file and the JPEG still picture file of the same still picture information are additionally recorded in the directories 500 and 600, and these MPEG still picture file and JPEG still picture file are deleted", Abstract).

Kiso and Asada are in the same field of endeavor of image file systems. It, therefore, would have been obvious to one of ordinary skill in the art to modify the invention of Kiso to include wherein a recording format of each of plural different sets of the image data and the program corresponds to one of the different kinds of video audio reproducing apparatuses as taught by Asada so that "an archive medium is made usable by two or more apparatus of a different kind which differs in an information format, and the convenience of an archive medium" (Asada, paragraph 63).

Regarding claim 2, 9, and 16. the combination of Kiso and Asada discloses the information recording of claim 1, wherein a recording format of the image data that

belongs to each of the plural sets of the image data and program is a different recording format (Asada, paragraph 46).

Regarding claim 3, 10, and 17, the combination of Kiso and Asada discloses the information recording medium of claim 1, wherein a resolution of the image data that belongs to each of the plural sets of the image data and program is a different resolution (Asada, paragraph 62).

Regarding claim 4, 11, and 18, the combination of Kiso and Asada discloses the information recording medium of claim 1, further comprising: a moving image data generated based on the image data, wherein a recording format of the moving image data corresponds to either one of the different kinds of video audio reproducing apparatuses (Asada, "a management file 300 for recording management information showing a relation between the MPEG still picture file and the JPEG still picture file is constructed to record the same still picture in the directories 500 and 600 as the MPEG still picture file and the JPEG still picture file.", abstract).

Regarding claim 5, 12, and 19, the combination of Kiso and Asada discloses the information recording medium of claim 4, wherein the moving image data generated by the image data and a difference data calculated according to an predetermined slide effect to each the image data (Kiso, paragraph 20).

Regarding claim 7, 14, and 20, the combination of Kiso and Asada discloses the information recording medium of claim 1, wherein the different kinds of video audio reproducing apparatuses includes a computer terminal and a DVD player (Kiso, The slide show device shown in drawing 1 is actually realized by a computer and its peripheral equipment… As the displaying means 3, a CRT display, a liquid crystal display, etc. are applicable.", paragraph 8; Asada, "will be reproduced with a DVD deck," paragraph 9).

Claims 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Kiso et al.(JP 2001-103415A provided in IDS) and Asada et al. (JP 2001-223980 provided in IDS) as applied to claim 1, further in view of Nagaishi et al. (JP 08-256307 A in IDS).

Regarding claim 6 and 13. the combination of Kiso and Asada discloses the information recording medium of claim 1, further comprising: a music audio data of format corresponds to one of the different kinds of video audio reproducing apparatuses.

Nagaishi teaches a music audio data of format corresponds to one of the different kinds of video audio reproducing apparatuses (Nagaishi, paragraph 60).

Kiso, Asada, and Nagaishi are in the same field of endeavor of information recording/reproducing systems. It, therefore, would have been obvious to one of ordinary skill in the art to modify the invention of the combination of Kiso and Asada to include comprising a music audio data of format corresponds to one of the different kinds of video audio reproducing apparatuses as taught by Nagaishi as it is well-known to anyone of ordinary skill in the art to utilize music audio data to generate a sound in synchronization with the slide show.

Claims 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiso et al.(JP 2001-103415A provided in IDS) in view of Asada et al. (JP 2001-223980 provided in IDS) and Nagaishi et al. (JP 08-256307 A in IDS).

Regarding claim 21. Kiso discloses an information recording medium production method comprising steps of:

reading an image data from a film or information recording medium provided by a customer; a program for enabling a computer to function as a slide show section to display a slide show based on the image data (Kiso, “A displaying means which can display a slide image, and a memory measure which memorized two or more graphics files, As it had the sequence table which defined an order on which two or more pictures are displayed in a slide show, said graphics file was read from said memory measure according to an order defined as a sequence table and it was made to display on said

displaying means, it was made to perform a slide show.", paragraph 4); a program for enabling a computer to function as a slide show section to display a slide show based on the image data on the display section (Kiso, "When a CD-ROM 6 is set to a CD-ROM read means 6 and an entry instruction means gives a start instruction of a slide show execution program 6a to the means 6, an arithmetic control means 1 reads the slide show execution program 6a to act as a slide show execution means. In the case of executing a slide show, the arithmetic control means 1 first reads a sequence table 6b to extract an image file defined in the sequence table 6b from an image file group 6c and allows a display means 3 to display the image.", abstract, IDS art).

Kiso does not disclose converting the read image data into data of formats to correspond to the different kinds of video audio reproducing apparatuses and recording plural sets of the image data and the program on information recording medium, wherein the image data and the music audio data stored in a format to corresponds to one of the different kinds of video audio reproducing apparatuses.

Asada teaches converting the read image data into data of formats to correspond to the different kinds of video audio reproducing apparatuses and recording plural sets of the image data and the program on information recording medium, wherein the image data and the music audio data stored in a format to corresponds to one of the different kinds of video audio reproducing apparatuses (Asada, "In the recoding medium, a picture file system 100 composed of a directory for MPEG animation 400 for recording an MPEG animation file, a directory for an MPEG still picture 500 for recording an MPEG still picture file, a directory for a JPEG still picture 600 for recording a JPEG still picture file

and a management file 300 for recording management information showing a relation between the MPEG still picture file and the JPEG still picture file is constructed to record the same still picture in the directories 500 and 600 as the MPEG still picture file and the JPEG still picture file. In order to additionally record or delete a still picture, the MPEG still picture file and the JPEG still picture file of the same still picture information are additionally recorded in the directories 500 and 600, and these MPEG still picture file and JPEG still picture file are deleted", Abstract).

Kiso and Asada are in the same field of endeavor of image file systems. It, therefore, would have been obvious to one of ordinary skill in the art to modify the invention of Kiso to include wherein a recording format of each of plural different sets of the image data and the program corresponds to one of the different kinds of video audio reproducing apparatuses as taught by Asada so that "an archive medium is made usable by two or more apparatus of a different kind which differs in an information format, and the convenience of an archive medium" (Asada, paragraph 63).

The combination of Kiso and Asada does not disclose displaying music selection image corresponds to a music audio data stored in a storage section so that a customer selectable music; converting the music audio data that corresponds to the music selected by the customer into data of formats to corresponds to the different kinds of video audio reproducing apparatuses; and a program for enabling a computer to function as a slide show section to display a slide show based on the image data as a playing music section to play music based on the music audio data in synchronization with the slide show.

Nagaishi teaches displaying music selection image corresponds to a music audio data stored in a storage section so that a customer selectable music (Nagaishi, “Voice data besides image data is recordable on MD., paragraph 58); converting the music audio data that corresponds to the music selected by the customer into data of formats to corresponds to the different kinds of video audio reproducing apparatuses(Nagaishi, “A device reads a script from MD (S1), reads a picture according to a script, and develops it to a built-in image memory (S2). Next, according to the specification matter specified as MD11, image display, voice synthesis, tone composition, etc. are performed (S3).; and a program for enabling a computer to function as a slide show section to display a slide show based on the image data as a playing music section to play music based on the music audio data in synchronization with the slide show (Nagaishi, “Drawing 7 is a flow chart which shows operation of a slide show. In order to realize a slide show, an image display device for exclusive use, a voice synthesizer, etc. are required.”, paragraph 60).

Kiso, Asada, and Nagaishi are in the same field of endeavor of information recording/reproducing systems. It, therefore, would have been obvious to one of ordinary skill in the art to modify the invention of the combination of Kiso and Asada to include recording music audio data to generate a sound in synchronization with the slide show as taught by Nagaishi as this is well-known to anyone of ordinary skill in the art.

Regarding claim 22. the combination of Kiso, Asada, and Nagaishi discloses the information recording medium production method of claim 21, wherein the conversion step converts a recording format of the image data that belongs to each of the plural sets of the image data and program into different recording format(Asada, paragraph 46).

Regarding claim 23. the combination of Kiso, Asada, and Nagaishi discloses the information recording medium production method of claim 21, wherein the conversion step compresses the music audio data that belongs to each of the plural sets of the image data and program at different compression rates(Asada, paragraph 62).

Regarding claim 24. the combination of Kiso, Asada, and Nagaishi discloses the information recording medium production method of claim 21, further comprising step of: generating a moving image data based on the image data, wherein the recording step records the moving image data as format corresponds to either one of the different kinds of video audio reproducing apparatuses(Asada, “a management file 300 for recording management information showing a relation between the MPEG still picture file and the JPEG still picture file is constructed to record the same still picture in the directories 500 and 600 as the MPEG still picture file and the JPEG still picture file.”, abstract).

Regarding claim 25. the combination of Kiso, Asada, and Nagaishi discloses the information recording medium production method of claim 24, wherein the moving image data generating step generates the moving image data and a difference data

calculated according to an predetermined slide effect to each the image data(Kiso, paragraph 20).

Regarding claim 26. the combination of Kiso, Asada, and Nagaishi discloses the information recording medium production method of claim 21, wherein the different kinds of video audio reproducing apparatuses includes a computer terminal and a DVD player(Kiso, The slide show device shown in drawing 1 is actually realized by a computer and its peripheral equipment… As the displaying means 3, a CRT display, a liquid crystal display, etc. are applicable.", paragraph 8; Asada, "will be reproduced with a DVD deck," paragraph 9).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELISA M. RICE whose telephone number is (571)270-1582. The examiner can normally be reached on 12:00-8:30p.m. EST Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vikkram Bali can be reached on (571)272-7415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elisa M Rice/
Examiner, Art Unit 2624

/Vikkram Bali/
Supervisory Patent Examiner, Art Unit 2624